Remarks

The Examiner has rejected claims 1, 5-6, 8-9, 11-16, 20-21, 23-24, 26-35, 37, 39-48, 51 and 53-54 under 35 U.S.C. §102(b) as being anticipated by United States Patent Number 5,988,287, issued in the names of Jordan, Jr. et al. (hereinafter "Jordan"). The Examiner has rejected claims 1-2, 5-6, 8, 10-17, 20-21, 23, 25-31, 33-37, 39-47, 49-51 and 53-54 under 35 U.S.C. §102(b) as being anticipated by United States Patent Number 5,228,507, issued in the names of Obrejanu et al. (hereinafter "Obrejanu"). The Examiner has rejected claims 4 and 19 under 35 U.S.C. §103(a) as being unpatentable over Obrejanu in view of European Publication number EP 0 952 302 (counterpart of United States Patent Number 6,199,628 issued in the names of Beck et al. (hereinafter "Beck")). The Examiner has rejected claims 7, 22, 38 and 52 under 35 U.S.C. §103(a) as being unpatentable over Obrejanu in view of European Publication number EP 0 999 343 (counterpart of United States Patent Number 6,349,772 issued in the names of Mullen et al. (hereinafter "Mullen")). The Examiner has objected to claims 3 and 18 as being dependent on a rejected base claim but has indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-54 were originally presented for examination. Claims 3, 18, 30, 33, 36, 46 and 49-50 have been cancelled by way of the

present response. New claims 55-67 have been added by way of the present response. Claims 1-2, 4-17, 19-29, 31-32, 34-35, 37-45, 47-48 and 51-67 are currently pending, of which, claims 1, 16, 27, 43 and 55 are in independent form. Favorable consideration of the present Response as currently constituted is respectfully requested.

Objection to Claims

The Examiner has objected to claims 3 and 18 as being dependent on a rejected base claim but has indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The applicant acknowledges and appriciates the Examiner's indication of the allowable subject matter of claims 3 and 18.

Rejection under 35 U.S.C. §102(b) by Jordan

The Examiner has rejected claims 1, 5-6, 8-9, 11-16, 20-21, 23-24, 26-35, 37, 39-48, 51 and 53-54 under 35 U.S.C. §102(b) as being anticipated by Jordan.

The applicant has amended claim 1 to incorporate the allowable subject matter of claim 3. Accordingly, the applicant believes that claim 1 and each of the claims dependent therefrom are in condition for allowance.

The applicant has amended claim 16 to incorporate the allowable subject matter of claim 18. Accordingly, the applicant believes that claim 16 and each of the claims dependent therefrom are in condition for allowance.

Claims 27 has been amended to read as follows:

> 27. (Currently Amended) A method for transmitting force to a well tool positioned in the wellbore, the method comprising the steps of:
>
> running a downhole force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool to a target location downhole;
>
> longitudinally securing the downhole force generator within the wellbore by operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft;
>
> operably engaging the well tool with the operating tool; and
>
> transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft.

Specifically, claim 27 now recites a downhole force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool as well as the structural interaction of the moveable shaft with the anchor and the operating tool including "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft" and "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft."

Jordan is directed to methods of releasing a packer that is connected to a tubing string. Specifically, Jordan teaches running

a through tubing release tool assembly into the well to break a shear pin of the packer which will allow the packer to be released from the well and retrieved to the surface as part of the tubing string. Two embodiments of the release tool are taught by Jordan. One embodiment uses pressure to operate the release tool to break the shear pin of the packer, the other uses a power jar to break the shear pin of the packer. Neither embodiment of the release tool includes an anchor as presently claimed. Instead, the anchor of Jordan is a portion of the packer which is the work piece operated on by the release tool. As such, Jordan does not teach "a force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool." In addition, Jordan does not teach "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft." Further, Jordan does not teach "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft." Accordingly, applicant believes the rejection of claim 27 and each of the claims dependent therefrom under 35 U.S.C. §102(b) as being anticipated by Jordan should be withdrawn.

Claims 43 has been amended to read as follows:

> 43. (Currently Amended) A method for dislodging a well tool positioned in the wellbore, the method comprising the steps of:
> running a fishing tool including a downhole power unit having a moveable shaft, an anchor and an operating tool to a target location downhole;

longitudinally securing the fishing tool within the wellbore by operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft;

operably engaging the well tool with the operating tool; and

dislodging the well tool by applying a force to the well tool with the operating tool in response to movement of the moveable shaft.

Similar to claims 27, claim 43 now recites a downhole force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool as well as the structural interaction of the moveable shaft with the anchor and the operating tool including "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft" and "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft." As state above, Jordan does not teach "a force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool." In addition, Jordan does not teach "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft." Further, Jordan does not teach "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft." Accordingly, applicant believes the rejection of claim 43 and each of the claims

dependent therefrom under 35 U.S.C. §102(b) as being anticipated by Jordan should be withdrawn.

Rejection under 35 U.S.C. §102(b) by Obrejanu

The Examiner has rejected claims 1-2, 5-6, 8, 10-17, 20-21, 23, 25-31, 33-37, 39-47, 49-51 and 53-54 under 35 U.S.C. §102(b) as being anticipated by Obrejanu.

The applicant has amended claim 1 to incorporate the allowable subject matter of claim 3. Accordingly, the applicant believes that claim 1 and each of the claims dependent therefrom are in condition for allowance.

The applicant has amended claim 16 to incorporate the allowable subject matter of claim 18. Accordingly, the applicant believes that claim 16 and each of the claims dependent therefrom are in condition for allowance.

The applicant has amended claim 27 as specified above. Specifically, claim 27 now recites a downhole force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool as well as the structural interaction of the moveable shaft with the anchor and the operating tool including "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft" and "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft."

Obrejanu is directed to a wireline pulling tool that is used to apply a large retrieving force on a pulling tool engaged with an object in the wellbore without having that force transmitted directly through the wireline. The retrieving tool is adapted to be lowered into the well bore on the wireline to a position where the pulling tool engages the stuck object. Slips carried on in the tool then anchor the tool against the tubular casing or tubing of the well bore and a controlled retrieving force generated in the tool by an electric motor and hydraulic pump is applied between the casing or tubing and the pulling tool to dislodge the object. As such, Obrejanu does not teach "a force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool." In addition, Obrejanu does not teach "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft." Further, Obrejanu does not teach "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft." Accordingly, applicant believes the rejection of claim 27 and each of the claims dependent therefrom under 35 U.S.C. §102(b) as being anticipated by Obrejanu should be withdrawn.

The applicant has amended claim 43 as specified above. Specifically, claim 43 now recites a downhole force generator including a downhole power unit having a moveable shaft, an anchor

and an operating tool as well as the structural interaction of the moveable shaft with the anchor and the operating tool including "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft" and "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft." As state above, Obrejanu does not teach "a force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool." In addition, Obrejanu does not teach "operating the anchor from a radially contracted configuration to a radially expanded configuration in response to movement of the moveable shaft." Further, Obrejanu does not teach "transmitting a force to the well tool with the operating tool in response to movement of the moveable shaft." Accordingly, applicant believes the rejection of claim 43 and each of the claims dependent therefrom under 35 U.S.C. §102(b) as being anticipated by Obrejanu should be withdrawn.

Rejection under 35 U.S.C. §103(a) by Obrejanu and Beck

The Examiner has rejected claims 4 and 19 under 35 U.S.C. §103(a) as being unpatentable over Obrejanu in view of Beck. Claim 4 is dependent on allowable claim 1 and claim 19 is dependent on allowable claim 16. Accordingly, applicant believes that claims 4 and 19 are also allowable.

Rejection under 35 U.S.C. §103(a) by Obrejanu and Mullen

The Examiner has rejected claims 7, 22, 38 and 52 under 35 U.S.C. §103(a) as being unpatentable over Obrejanu in view of Mullen. Claim 7 is dependent on allowable claim 1, claim 22 is dependent on allowable claim 16, claim 38 is dependent on allowable claim 27 and claim 52 is dependent on allowable claim 43. Accordingly, applicant believes that claims 7, 22, 38 and 52 are also allowable.

New claims

The applicant has added new claims 55-67. New claim 55 reads as follows:

> 55. (New) A downhole force generator adapted to be moved to a target location within a wellbore for interaction with a well tool positioned in the wellbore, the downhole force generator comprising:
>
> a downhole power unit having a moveable shaft;
>
> an anchor operably associated with the downhole power unit, the anchor operable between a running configuration and an anchoring configuration in response to movement of the moveable shaft, in the anchoring configuration, the anchor longitudinally secures the downhole force generator within the wellbore, the moveable shaft of the downhole power unit extending through a longitudinal bore of the anchor; and
>
> an operating tool operably associated with the moveable shaft of the downhole power unit and operably engageable with the well tool such that when the operating tool is operably engaged with the well tool and the anchor is in the anchoring configuration, movement of the moveable shaft will transmit a force to the well tool via the operating tool.

Similar to claims 27 and 43, claim 55 recites a downhole force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool as well as the structural interaction of the moveable shaft with the anchor and the operating tool. Specifically, claims 55 recites that the anchor is operable "between a running configuration and an anchoring configuration in response to movement of the moveable shaft" and that the operating tool is "operably associated with the moveable shaft ... such that ... movement of the moveable shaft will transmit a force to the well tool via the operating tool." As state above, neither Jordan nor Obrejanu teach "a force generator including a downhole power unit having a moveable shaft, an anchor and an operating tool." In addition, neither Jordan nor Obrejanu teach that the anchor is operable "between a running configuration and an anchoring configuration in response to movement of the moveable shaft." Further, neither Jordan nor Obrejanu teach that the operating tool is "operably associated with the moveable shaft ... such that ... movement of the moveable shaft will transmit a force to the well tool via the operating tool." Accordingly, applicant believes that claim 55 and each of the claims dependent therefrom are allowable.

Fee Statement

Compared to the initial filing, the number of independent claims has increased by one and the total number of claims has

increased by five. Form PTO-2038 is enclosed herewith authorizing payment of $450.00 for the extra claim fee. Applicant believes no additional fees are due for the filing of this response. If any additional fees are due or any overpayments have been made, however, please charge or credit our deposit account (Deposit Account No. 03-1130).

Conclusion

In view of the forgoing, the Examiner is respectfully requested to allow claims 1-2, 4-17, 19-29, 31-32, 34-35, 37-45, 47-48 and 51-67 presented for consideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 20th day of December, 2005.

Respectfully submitted:

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